

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

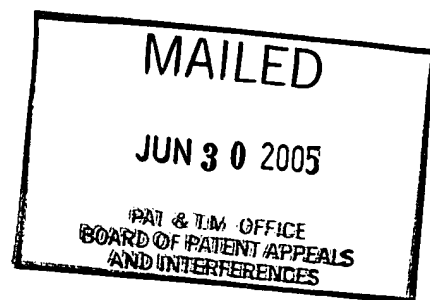
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR D. TAYLOR

Appeal No. 2005-1439
Application No. 09/943,987

ON BRIEF



Before HANLON, JEFFREY SMITH and PAWLIKOWSKI, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-12, all of the claims pending in the application. The claims on appeal are directed to a 22 karat gold alloy and a master alloy for combining with gold. Claims 1 and 5 are illustrative and read as follows:

1. A 22K gold alloy comprising, by weight:
silver: 2-6%
cobalt: 0.1 to 2%
optionally boron up to 0.5%
copper: 0.33% - 8.40%.
5. A master alloy for combining with gold, comprising, by weight:
silver: 32-96%
cobalt: 1.6-32.00%
optionally boron up to 8%
copper: 5.28-66.40%.

The sole issue on appeal is whether the examiner properly rejected claims 1-12 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Diamond.¹

Grouping of claims

The appellant groups the claims on appeal as follows (Brief, p. 2):

- I. Claims 1-6 and 8-12 stand or fall together; and
- II. Claim 7 stands or falls alone.

¹U.S. Patent No. 5,384,089 granted January 24, 1995, to Diamond.

For purposes of this appeal, the patentability of claims 2-6 and 8-12 stands or falls with the patentability of claim 1, and the patentability of claim 7 stands or falls alone. See 37 CFR § 1.192(c)(7) (2003); 37 CFR § 41.67(c)(1)(vii) (2004).

Discussion

A. Rejection of claims 1-6 and 8-12 under 35 U.S.C. § 102(b)

According to Diamond, the disclosed invention contemplates improved yellow gold karat metal alloys ranging from 8 karat to 22 karat. See col. 2, lines 13-15. Diamond provides examples of 8 karat, 10 karat, 14 karat and 18 karat gold alloys but does not provide an example of a 22 karat gold alloy. The examiner points to a gold alloy in claim 5 of Diamond wherein the lower limit of silver corresponds to the lower limit of silver recited in claim 1, the lower limit of copper falls within the range of copper recited in claim 1, and the upper limit of cobalt corresponds to the upper limit of cobalt recited in claim 1. Ex parte Lee, 31 USPQ2d 1105, 1106 (Bd. Pat. App. & Int. 1993). However, the alloy is not limited to a 22 karat gold alloy (91.67 parts gold) but rather includes a gold alloy ranging from 8 karat (33.3 parts gold) to greater than 22 karat (92 parts gold).

Since Diamond does not expressly describe an example of a 22 karat gold alloy comprising amounts of silver, cobalt and copper which either "touch" or fall within the ranges of

silver, cobalt and copper recited in claim 1, Diamond does not anticipate claim 1.² See Minnesota Mining and Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1572, 24 USPQ2d 1321, 1332 (Fed. Cir. 1992) (to anticipate, a reference must sufficiently describe the claimed invention to have placed the public in possession of it).

The rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Diamond is reversed. Since the patentability of claims 2-6 and 8-12 stands or falls with the patentability of claim 1, the rejection of claims 2-6 and 8-12 under 35 U.S.C. § 102(b) as being anticipated by Diamond is also reversed.

B. Rejection of claim 7 under 35 U.S.C. § 102(b)

Claim 7 is dependent on claim 1. See 37 CFR § 1.75(c) (2004) ("Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim."). Therefore, the rejection of claim 7 under 35 U.S.C. § 102(b) as being anticipated by Diamond is reversed.

C. Rejection of claims 1-6 and 8-12 under 35 U.S.C. § 103(a)

The examiner also relies on the gold alloy recited in claim 5 of Diamond to establish that Diamond renders obvious the appellant's claimed 22 karat gold alloy. See Answer, pp. 3-4.

²The gold alloy recited in claim 1 also comprises "optionally boron up to 0.5%." Thus, boron is not a required element in the claimed alloy. See also Brief, p. 2 (recognizing that "boron is optional").

The appellant appears to recognize that claim 5 encompasses the claimed alloy but argues that the broad disclosure is not sufficient to support an obviousness rejection, especially where Diamond does not provide an example of a 22 karat gold alloy. Brief, p. 7.

With respect to the rejection under 35 U.S.C. § 103(a) at issue, it is of no moment that Diamond does not provide a specific example of a 22 karat gold alloy. See In re Chapman, 357 F.2d 418, 424, 148 USPQ 711, 716 (CCPA 1966) (a reference is not limited to its specific illustrative examples); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976) (all disclosures of the prior art must be considered under 35 U.S.C. § 103). As explained above, Diamond expressly states that the disclosed invention contemplates gold alloys ranging from 8 karat to 22 karat. See col. 2, lines 13-15. Furthermore, the gold alloy in claim 5 of Diamond encompasses 22 karat gold alloys (91.67 parts gold), and the ranges of silver, cobalt and copper in that alloy clearly overlap the appellant's claimed ranges of silver, cobalt and copper. It is well-settled that where the difference between the claimed invention and the prior art is overlapping ranges, the appellant must show that the particular ranges are critical. In re Wertheim, 541 F.2d 257, 267, 191 USPQ 90, 100 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Apparently in an attempt to distinguish the claimed gold alloy from the gold alloy disclosed in Diamond, the appellant argues that the claimed alloy has sufficient hardness for jewelry applications and desirable color characteristics. See Brief, p. 6. To the extent that the appellant is arguing that the claimed ranges of silver, copper and cobalt are critical, the appellant

has failed to point to any evidence in the record which establishes that the claimed ranges are indeed critical. See In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965) (arguments in the brief do not take the place of evidence in the record).

We further note that the appellant's claim 5 is directed to a master alloy for combining with gold. Diamond also indicates that the disclosed alloys may be made as master alloys to be mixed with gold. See col. 2, lines 24-25; compare appellant's specification, p. 9. Thus, one of ordinary skill in the art would have understood that the alloy recited in claim 2 of Diamond could have been made as a master alloy and then mixed with gold. Working backwards to calculate the amounts of silver, copper and cobalt in the master alloy used to make the alloy of claim 2, one of ordinary skill in the art would have understood that the master alloy contains 60.8% silver, 29.28% copper and 8% cobalt, amounts which clearly fall within the ranges of silver, copper and cobalt recited in the appellant's claim 5. Cf. Wertheim, 541 F.2d at 267, 191 USPQ at 100 (the disclosure in the prior art of any value within a claimed range is an anticipation of the claimed range).

For the reasons set forth above, the appellant has failed to rebut the prima facie case of obviousness set forth by the examiner. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) ("[a]fter a prima facie case of obviousness has been established, the burden of going forward shifts to the applicant"). Therefore, the rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Diamond is affirmed. Since the patentability of claims 2-6

and 8-12 stand or fall with the patentability of claim 1, the rejection of claims 2-6 and 8-12 under 35 U.S.C. § 103(a) as being unpatentable over Diamond is also affirmed.

D. Rejection of claim 7 under 35 U.S.C. § 103(a)

Claim 7 reads as follows:

7. The alloy of claim 1 in the form of a jewelry casting, a stamping, a wire or a sheet.

The appellant argues that there is "no hint" in Diamond that the constructions recited in claim 7 could be made from 22 karat gold alloys. See Brief, p. 8.

To the contrary, Diamond expressly states that the disclosed invention contemplates gold alloys ranging from 8 karat to 22 karat and indicates that the disclosed gold alloys are particularly suited for the casting of jewelry articles such as rings, bracelets, earrings, and the like. See Abstract; col. 2, lines 13-15; see also claim 5 of Diamond (reciting gold alloys, including 22 karat gold alloys, "suitable for investment casting of articles of jewelry"). Therefore, the rejection of claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Diamond is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Adrian Popescu Haula

ADRIENE LEPLANE HANLON
Administrative Patent Judge

Jeffrey E. Stone

JEFFREY T. SMITH
Administrative Patent Judge

Beverly A. Cawthon

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

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